

**REMARKS**

Applicant respectfully requests reconsideration and continued examination of this application in view of the amendments and the following remarks. Claims 1-19 are pending in this application.

**1. Claim Amendments**

Claim 18 was amended to eliminate extraneous language. None of the amendments to the claims narrow the claim scope or add new subject matter.

**2. Prior Art Rejections**

Claims 1-12 and 14- 18 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application No. 2005/0044792 to Beggs et al ("Beggs"). Claims 13-19 were rejected under 35 U.S.C. 103(a) as being unpatentable over Beggs in view of Thacker (U.S. Patent No. 6,359,564). Applicant respectfully traverses the rejections.

**3. Beggs is Not Prior Art to the Present Application**

Beggs is not prior art because Applicant is swearing behind Beggs by showing conception, reasonable diligence beginning before the filing date of Beggs, namely June 20, 2003 until the filing of the application and constructive reduction to practice by filing the application on July 25, 2003. To that end Applicant has attached the Declarations under 37 C.F.R. § 1.131 of Roger M. Masson and James D. Ryndak.

Documentary evidence of conception and constructive reduction to practice is provided by the present patent application.

Regarding diligence, although each case stands on its own facts, a review of cases is instructive. In *Poage v. Dyer*, 184 USPQ 223 (POBdInt 1974), the USPTO's Board of Interferences excused a 10-month delay in filing a patent application, because of other work and litigation. In *Emery, Howe and Marcella v. Ronden and Rabel*, 188

USPQ 264 (POBdInt 1974), the USPTO's Board of Interferences stated, "... it is not necessary that an inventor or his attorney should drop all other work and concentrate on the particular invention involved ...." Cases where diligence has not been shown frequently are due to a failure to show with specificity what activities occurred and when. *E.g., In re Harry*, 333 F.2d 920, 923, 142 USPQ 164, 166 (CCPA 1964) (statement that the subject matter "was diligently reduced to practice" is not a showing, but a mere pleading); *Kendall v. Searles*, 173 F.2d 986, 993, 81 USPQ 363, 369 (CCPA 1949) (Diligence requires that applicants must be specific as to dates and facts).

The Declarations and attachments show that from June 2, 2003 to July 15, 2003, work was performed diligently on the subject patent application. On June 2, 2003, preparation of the patent application was discussed with R. Fielmann, inventor. Preparation of the patent application began on June 3, 2003. The work consisted of work actively occurring at least three times during a week. During the short periods of inactivity on the patent application, Messrs. Masson and Ryndak attended to many other pressing legal matters.

On July 15, 2003, the patent application and various formal papers were mailed to Mr. Fielmann, the inventor, for his review and approval. On July 21, 2003, Mr. Fielmann reviewed the patent application, signed the various formal papers, and mailed the application back to the law firm of Ryndak & Suri. Evidence of this is provided by the signed Declaration and Power of Attorney of the present application, which bears the date of "7/21/03." On July 25, 2003, the patent application was filed.

The Declarations and exhibits show reasonable diligence beginning June 3, 2003 towards the filing of the present patent application. Applicant is only attempting to show reasonable diligence for a period of five weeks, not 10 months. Messrs. Ryndak and Masson have provided affidavits showing that they frequently worked on the present application and also worked on other pressing matters. Therefore, a showing of reasonable diligence has been made. Thus, Beggs is not prior art to the present application. Consequently, Applicant requests that all rejections based on Beggs be withdrawn.

**4. Even if Applicant cannot swear behind Beggs, the rejection over Beggs in view of Thacker is improper because Thacker teaches away from the invention**

Thacker teaches away from the claimed invention. In particular, Thacker teaches away from ceasing or shutting off of an audible warning "after a predetermined period of time in response to detected motion" and resetting the audible warning device "when motion is no longer detected by the motion detector device."

Thacker teaches that when a person enters an office cubicle, a green light is constantly illuminated. Col. 4, lines 54-59. If a person stays in the cubicle and does not move for a predetermined length of time, Thacker teaches that this is an emergency condition illuminating a red emergency alarm. Col. 4, lines 38 – 53 and lines 59-65. Thacker also teaches the use of a beeper 112 for emergencies. See abstract; col. 4, lines 12-23; col. 4, lines 64-65; and col. 7, lines 56-62. The beeper 112 will sound intermittently while the red light flashes. Col. 4, lines 62-65; col. 7, lines 56-58. Thacker does not disclose any other use of the beeper. Thus the beeper sounds only when a person is detected in a cubicle, but movement is not.

Thacker teaches away from another limitation of claims 13 and 19. Dependent claim 13 claims an audible alarm device that gives an audible warning when a person is detected near the detector device that shuts off the warning after a predetermined period of time of continued motion, and that resets the audible warning device after no motion is detected so that the device may give an audible warning again. Dependent claim 19 claims a method of shutting off the audible warning after a predetermined period of time and resetting the audible alarm device when motion is no longer detected by the motion detector device. In other words, the claimed invention shuts off the audible warning after a predetermined time in response to motion and later resets the device after no motion to enable it to give an audible alert in response to a future detection of a person. In contrast, Thacker does not sound the beeper in response to motion; it sounds the beeper in response to the presence of a person and no motion. Thus, Thacker teaches the opposite of "shutting off the audible warning after a predetermined period of time in response to detected motion by the motion detector device." Consequently, Thacker teaches away from resetting the alarm "when motion is

no longer detected by the motion detector device.” Therefore, claims 13 and 19 are independently patentable over Beggs in view of Thacker.

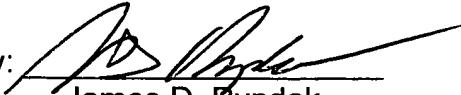
**5. Even if the rejection of claims 13 and 19 is not improper because Thacker teaches away from the invention, the rejection is improper because Thacker is not analogous art.**

Additionally, the claims are patentable because Thacker is not analogous prior art. The present invention is directed towards alerting a person approaching a substantially transparent door of the proximity of the door. Thacker is entitled “Occupancy Status Indicator” and is generally directed to alerting third parties of the occupancy of a cubicle. Occupancy status indicators are commonly used in bathroom stalls, portable toilets commonly known as porta-potties, and airplane bathrooms, which indicate whether the toilet is occupied based on whether the door is locked or not. Although superficially it may seem that Thacker and the present invention are structurally similar in that they both have a detector device and an audible alarm device, they are functionally very different. Thacker’s motion detector and beeper have the function of alerting third parties to the possibility that a detected first party is unconscious. The present invention is directed towards alerting a conscious, first party of a substantially transparent door. Thus, Thacker is not analogous prior art because Thacker is from a different field and is not functionally similar to the claimed invention. See M.P.E.P. § 2141.01(a) *citing In re Clay*, 23 USPQ2d 1058 (Fed. Cir. 1992) (overturning PTO finding of obviousness because reference disclosing the use of gel to reduce the permeability of formations to enhance recovery of oil was not in the same field and was not functionally similar to claims directed to the use of a gel to occupy the bottom of a petroleum storage tank).

**CONCLUSION**

In view of the foregoing, all of the rejections have been overcome and claims 1-19 are allowable. An early indication of allowance is solicited.

Respectfully submitted,

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